

Attorney Docket No. Mrcocf-2-4277

Application Serial No. 10/814,091

## REMARKS

### REVIEW

The application as currently amended sets forth claims 1-12, 14, and 16 of which claims 1, 11, and 16 are independent claims. No claims have been indicated as allowed in view of the prior art. Claim 16 stands rejected under 35 U.S.C. § 102(b) as being anticipated by *Rehman et al.* (U.S. Patent No. 5,012,629). Claims 1, 4, 5, and 7-10 stand collectively rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over *Rehman et al.* Claims 2, 3, 6, 11, 12, and 14 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rehman et al.* in view of *Shori* (U.S. Patent No. 5,419,245).

### PRIOR ART REJECTIONS

As all of the claims stand rejected in one manner or another in light of the *Rehman et al.* reference, it is to this reference that the majority of this discussion shall be directed. *Rehman et al.* teaches a method for the commercial manufacture of coffee infusion pods suitable for use in both American and European style coffee brewing apparatus. In Figure 2, *Rehman et al.* depicts a schematic view of a mold for use in the method claimed. The mold includes a depression for receipt of a first layer of filter material, a ground coffee, and over which a second layer of filter material may be placed. In cooperation with such mold is depicted a form for compressing the first layer of filter material into the depression and for sealing the second layer to the first layer about their periphery to complete the pod's manufacture.

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With regard to both the anticipatory and obviousness rejections of the claims, it is noted that each of the independent claims include a feature not taught, suggested or disclosed by *Rehman et al.*, alone or in combination with any of the other cited prior art. Specifically, each of the independent claims an infusion pod manufacturing apparatus capability of simultaneously performing a sealing and packing operation on the infusion pod being made. In particular, the specification of *Rehman et al.* precisely states:

A top piece of filter paper 26 is then placed over the bottom filter paper, with the coffee in the pouch formed therebetween. An electrically heated annular sealing head 28, driven as by a vertically driven shaft 30, is then pressed over the first and second sheets of filter paper in the 1/2 inch margin area around the mold cavity, and a force is exerted on the heated sealing head for a given period of time, pressing and sealing together the first and second sheets of filter paper around the 1/2 inch margin area 32. The completed infusion coffee filter pack 34 is then removed and trimmed...

Column 14, lines 37-48. Nowhere within *Rehman et al.* is it even suggested that the coffee need be packed within the infusion pod. On the contrary, a great deal of time is spent in detailing the additional amount of space (referred to as "headspace") that should be left to compensate for the expansion of the infusible material within the pod as it absorbs moisture during the brewing process.

**35 USC § 102(b) Rejections of Claims 1, 4, 5, 7-10 and 16**

In light of the above and with guidance from the following case law, it is respectfully submitted that the present rejections of claims 1, 4, 5, 7-10, and 16 are improper as the cited prior art fails to expressly disclose each and every element of the claimed invention. "Anticipation requires the disclosure in a single prior art reference of each element of the claims under

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consideration." W. L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Further, any argument that the bolt (reference number 22) is inherently capable of performing the simultaneous task of packing the coffee grounds within the infusion pod as the sealing process is being completed by the bolt carrier (reference number 30) is similarly improper. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 49 U.S.P.Q.2d 1949, 1950-1 (Fed. Cir. 1999). *Rehman et al.* failed to claim or even describe the use of the bolt (22) for any purpose other than forcing the first or bottom layer of filter material to conform to the shape of the depression within the mold. Further, the nature of the description of this process implies that the bolt is mechanically driven and not free to operate if biased by a spring as in the present claims.

Failing to expressly claim each and every element of the claimed invention within independent claims 1 and 16, it is respectfully submitted that such rejection is improper and withdrawal of same is requested. As such, it is submitted that independent claims 1 and 16 are in condition for allowance. Claims 4, 5, and 7-10 depend from and further limit independent claim 1. It is respectfully submitted that they are similarly in condition for allowance.

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***Alternative 35 USC § 103(a) Rejection of Claims 1, 4, 5, and 7-10***

Again in light of the above discussion and with guidance from the following case law, it is respectfully submitted that the present grounds of rejection are improper and withdrawal of same is earnestly solicited. *Rehman et al.* fails to teach, suggest or make obvious the claimed simultaneous sealing and packing operations of the present invention. It is respectfully submitted that it does not even appear that the Examiner is suggesting that the cited reference is capable of such simultaneous operations. In the event, however, that the Examiner were to make such a claim, it is noted that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-4 (Fed. Cir. 1992). The failure of *Rehman et al.* to include even one reference to any step related to packing of the infusible material leads one to believe that such a step was either undesired or not even considered by *Rehman*.

Absent the teaching or suggestion of such a feature of the present invention, it is respectfully submitted that *Rehman et al.* cannot properly serve as a basis for a § 103(a) rejection of the present claims. Withdrawal of this alternative ground of rejection and issuance of a formal Notice of Allowance as to these claims is earnestly solicited.

***35 USC § 103(a) Rejection of Claims 2, 3, 6, 11, 12, and 14***

In light of the above discussion and the following case law, it is respectfully submitted that the present rejection is improper and withdrawal of same is requested.

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As discussed above, *Rehman et al.* fails to teach or make obvious all of the claimed elements of the independent claims. Specifically, the claimed capability of the present invention to simultaneously seal the infusion pods first and second layers of filter material while packing the infusible material within the pod itself is not even suggested. While the operation of the apparatus in Figure 2 of *Rehman et al.* is admittedly similar to the present invention, it is noted that "[a]n invention need not *operate* differently than the prior art to be patentable, but need only *be* different." Hewlett-Packard Co. v. Bausch & Lomb, Inc., 909 F.2d 1464, 1468, 15 U.S.P.Q.2d 1525, 1528 (Fed. Cir. 1990). It is respectfully submitted that the present invention is different in both its operation and design. As such, it is believed that the present ground of rejection is improper and claims 2, 3, 6, 11, 12, and 14 are presently in condition for allowance. It is respectfully requested that the rejection be withdrawn and the issuance of a formal Notice of Allowance be issued.

#### CITED RELEVANT PRIOR ART

It is not believed that any of the prior art cited either by the Examiner or the Applicant, alone or in combination either with each other or other cited prior art teaches, discloses, suggests or makes obvious the claimed features of the present invention.

#### CONCLUSION

In view of the foregoing, Applicants respectfully request withdrawal of the current grounds of rejection and the issuance of a formal Notice of Allowance. The Examiner is invited to

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telephone the undersigned at his/her convenience should only minor issues remain after consideration of this amendment in order to permit early resolution of the same.

Respectfully submitted,

11/14/06  
Date

Charles R. Ducker  
Charles R. Ducker, Jr.  
Reg. No. 46,542